

## **REMARKS**

### **I. Amendment Of The Drawing**

The amendment to Figure 1 is made after consultation and suggestions by the Special Program Examiner, as are memorialized in the Decision On Petition dated on the 18<sup>th</sup> of May 2005. As is explained in that Decision that, the structure represented in thin-line in Figure 1 is a representation of the prior art structure; and that:

“Figure 1 illustrates, by way of a drawing, subject matter described in the written specification by language, which subject matter petitioners have stated to be prior art. It is the subject matter that constitutes “prior art”, and whether that subject matter is accurately described by written words or is accurately portrayed by illustration in a drawing, is immaterial to the status of that subject matter as being prior art, at least insofar as the current state of the record is concerned.”

Consequently, entry of this Amendment will result in withdrawal of the objection to the drawings, as suggested by the Special Program Examiner.

### **II. Status Of Pending Claims**

By this Amendment, claim 1 is amended to incorporate one change in number requested by the Examiner. Formerly allowable dependent claims 11 and 19 are amended to appear in independent form. Thus, claims 1 through 4 and 6 through 46 remain pending in this application, with claims 21 through 34 allowed and claims 35 through 37 and 44 through 46 withdrawn from consideration.

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<sup>1</sup> *Decision On Petition* dated 18 May 2005. The third complete paragraph on Page 3.

### **III. Related U.S. Patent Applications**

The Examiner's attention is respectfully invited to consider the status of the related patent application; Applicant's national phase application under 35 U.S.C. §371 of PCT International Application No. PCT/IB99/00277 was issued on October 21, 2003 as U.S. Patent No. 6,634,060.

### **IV. Election/Restrictions**

**First**, a Petition to withdraw the finality of the restriction requirement was previously filed, but no *Decision On Petition* has issued by the Special Program Examiner as of the date of this Paper.

**Second**, the Examiner is invited to note that this is a national phase of a Patent Cooperation Treaty application. The Examiner's reasoning and the withdrawal of claims 35 through 37 and 44 through 46, is not in accordance with the Patent Cooperation Treaty and its implementing regulations.<sup>2</sup> Under the Article VI, Clause 2 of the Constitution of the United

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<sup>2</sup> The decision in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986) held that the Patent and Trademark Office interpretation of 37 CFR 1.141(b)(2) as applied to unity of invention determinations in international applications was not in accordance with the Patent Cooperation Treaty and its implementing regulations. In the Caterpillar international application, the USPTO acting as an International Searching Authority, had held lack of unity of invention between a set of claims directed to a process for forming a sprocket and a set of claims drawn to an apparatus (die) for forging a sprocket. The court stated that it was an unreasonable interpretation to say that the expression "specifically designed" as found in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).

States, “all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land ... .” PCT applications are filed under the *Patent Cooperation Treaty*, which contains its own implementing regulations. PCT Article 3(4)(iii) and 17(3)(a), together with PCT Rule 3.1 and 37 CFR §1.475.

Even if MPEP expressly stated that “the consideration of unity of invention of claims of different categories should be made without regard to the practice in national applications filed under 35 U.S.C. §111,” the Examiner’s reasoning utterly ignores the primacy of the U.S. Constitution and the law of the land embodied in treaties such as the Patent Cooperation Treaty; in other words, the Examiner’s reasoning is still based on the practice in national applications filed under 35 U.S.C. §111.

Under 37 CFR §1.475(b)(1), a “product and a process specially adapted for the manufacture of said product” and under 37 CFR §1.475(b)(2), a “product and process of use of said product”, “will be considered *to have unity of invention* ... .”<sup>3</sup> Consequently, process claims 35 and 44, which are “specially adapted for the manufacture of said product” within the literal meaning of 37 CFR §1.475(b)(1), are *prima facie* endowed with *unity of invention* and must be examined.

**Third**, 37 CFR §1.145 – entitled *Subsequent presentation of claims for different invention*, places the option of election solely upon the Applicant, and not upon the Examiner.

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<sup>3</sup>

Nothing in 37 CFR §1.475(b)(1) requires Applicant to limit the scope of either the product or process claims; moreover, 37 CFR §1.475(b)(1) does not require that either the product claim or the process claim be written so narrowly that the process is exclusive of all products other than the product claimed.

37 CFR §1.145 provides the Examiner with no authority to declare claims withdrawn from examination. Accordingly, absent the application of 37 CFR §1.145, examination of claims 35 through 37 and 44 through 46 is required.

**Fourth**, the traversal made in the previous Response is hereby incorporated and repeated.

#### **V. Claim Rejections - 35 U.S.C. §112**

Claims 1-4 and 6-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, each pair of hinge connections makes a first angle and defines a plane. Since there are two pairs of hinge connections recited in claim 1, “the planes” and “each said plane” have antecedent basis. The applicant also amended claim 1 to conform with the Examiner’s suggestion by inserting the passive article “of”. Accordingly, the basis for this rejection is rendered moot.

#### **VI. Claim Rejections - 35 U.S.C. §102(b)**

Claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Nozawa (U.S. Pat. No. 5,148,912). Applicant respectfully traverses this rejection for the following reasons.

**First**, the basis given by the Examiner to support this rejection is geometrically

impossible and is contrary to the express teachings of Nozawa '912. The Examiner asserted that the closure of Nozawa '912 illustrated in figures 6-9 anticipates the claimed closure, and further stated that, regarding the inclination of the planes of the hinge elements, the feature (*i.e.*, each of said planes is inclined relative to a central closure axis) is not recited in the rejected claims. The fact is that "each said plane"<sup>4</sup> of the hinge connections are not taught by Nozawa '912 as being "inclined relative to a central closure axis"<sup>5</sup>, as may be confirmed by even a cursory examination of Figures 3, 4 and 5 of the first embodiment of Nozawa '912 and of Figures 7, 8 and 9 of the second embodiment of Nozawa '912; the exhaustive geometric analysis provided by Figures 5 and 9 of Nozawa '912 may not be summarily ignored in an application of 35 U.S.C. §102(b). Nowhere does the final Office action address the patent inconsistencies between the Examiner's interpretation of Nozawa '912 and the actual teachings expressed by Nozawa '912; this deficiency is the antithesis of the completeness mandated by 37 CFR §1.104(a), (b) and (c). Clarification is respectfully requested. The planes shown by these Figures are parallel, and can never therefore intersect either (*i*) one another or (*ii*) the axis of closure of Nozawa '912. Absent either feature, there is no anticipation under 35 U.S.C. §102(b), and maintenance of this rejection would be improper. The Examiner's assertion is a geometric impossibility and the final Office lacks the completeness required under 37 CFR §1.104(a), (b) and (c); clarification is respectfully requested.

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<sup>4</sup> Applicant's claim 1, line 11.

<sup>5</sup> Applicant's claim 1, lines 11 and 12.

**Second**, the Examiner also argued that any axis that is centrally located on the closure is a central axis to which the planes are inclined either horizontally or vertically. This assertion is immaterial; under 35 U.S.C. §102(b), the Examiner must consider each of these claims in their entireties, rather than in isolated phrases. The “planes” formed by Nozawa ‘912 illustrated in Figures 6 through 9 are not inclined relative to a “closure axis”.

More specifically, the Examiner’s attention is invited to note that in Figures 8 and 9, in the closed position, shown with solid lines in Figure 8, that the two opposite sides 7a, 7b are shown parallel to one another; this is confirmed by the top view of the first embodiment in Figure 4 (Nozawa ‘912 fails to provide a top view of the second embodiment) where opposite sides 7a, 7b, for both *resilient belts 7* lie **perpendicular** to the plane of the drawing and to the Sheet 2 of the drawing. The axis of closure must also lie **perpendicular** to the plane of the drawing and to the Sheet 2 of the drawing. Planes formed by opposite sides 7a, 7b, for both *resilient belts 7* which lie **perpendicular** to the plane of the drawing and to the Sheet 2 of the drawing, are necessarily parallel to one another. The axis of closure, which is also perpendicular to opposite sides 7a, 7b, for both *resilient belts 7*, lies perpendicular to the plane of the drawing and to the Sheet 2 of the drawing, is therefore parallel to opposite sides 7a, 7b. Consequently, planes formed by opposite sides 7a, 7b of *resilient belts 7* can not:

- (i) both perpendicularly intersect the plane of the drawing and Sheet 2 of the drawing and
- (ii) and also be ***inclined relative to a central closure axis***<sup>6</sup> when that central closure axis is simultaneously parallel to opposite sides 7a, 7b of *resilient belts 7*.

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<sup>6</sup> Claim 1, lines 11, 12.

In short, the basis given by the Examiner is unsupported by the express teachings of Nozawa '912 and that basis depends upon a geometric impossibility. If the Examiner believes that either Figures 3, 4, 5, 8 or 9 of Nozawa '912 are inaccurate, the Examiner is requested to so state in subsequent Office correspondence.

Claims 1, 38 and 41 expressly recite that *each of said planes is inclined relative to a central closure axis*. (See line 12 in claim 1, line 12 in claim 38, lines 15-16 in claim 41.) Nonetheless, the Examiner improperly asserted that the above feature is not recited in the claims; clarification of the Examiner's statement is respectfully requested pursuant to 37 CFR §1.104(a) and (b).

In view of the Examiner's reasoning recited in the Office action, it is not clear why the Examiner thinks that the planes of Nozawa '912 are inclined to the closure axis. If the Examiner conceived that a "closure axis" can be a line (*i.e.*, an imaginary slant line in Figs. 6, 8 and 9 of Nozawa '912) which is different from the line (*i.e.*, closure axis A) as shown in Fig. 2 (as amended on September 25, 2004) of the present application, please consider the meaning of the term "closure axis."

"The terms of a claim will be given their ordinary meaning, unless it appears that the inventor used them differently." *ZMI Corp. V. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 6 USPQ2d 1557 (Fed. Cir. 1988). In defining the meaning of key terms in a claim, reference may be had to the specification, the prosecution history, prior art, and other claims. *Minnesota Mining & Manufacturing Co. V. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

Here, the “closure axis” is clearly defined in the specification and/or Fig. 2 (See “A”, in Fig. 2, which is referred to as a closure axis.)

In response to the applicant’s response filed on October 13, 2004, the Examiner merely argued that the central vertical axis depicted in the drawings is not read into the claims. The Examiner did not provide the reason why reference cannot be the specification for defining the meaning of key terms in a claim.

Even assuming that the Examiner successfully traverses the above reasoning, the Examiner’s attention is invited to consider that the ordinary or dictionary meaning of the term “axis” is (1) a straight line about which a body or geometric object rotates or may be conceived to rotate, or (2) a line about which the object is symmetric, or (3) a center line to which parts of a structure or body may be referred, or (4) an imaginary line to which elements of a work of art are referred for measurement or symmetry and the like. (*The American Heritage Dictionary of the English Languages*, 3<sup>rd</sup> ed., Houghton Mifflin Company.)

With respect to the term “inclined”, it should be noted that the ordinary and/or dictionary meaning of “incline” is “to deviate from the horizontal or vertical.” (*The American Heritage Dictionary of the English Languages*, 3<sup>rd</sup> ed., Houghton Mifflin Company.) Unlike the Examiner’s definition of “the incline angle”, an inclination angle under the ordinary and/or dictionary meaning does not include either 90 degrees, 180 degrees, or 270 degrees.

Even under the ordinary or dictionary meaning of the definition of “central closure axis”, the planes of Nozawa ‘912 are not inclined relative to any conceivable central closure axis in Figs. 6-9 for the following reasons.



As shown in Fig. 8 of Nozawa '912, Nozawa '912 clearly shows that the planes are vertical. Also, Fig. 9 of Nozawa '912 more clearly shows that the plane (defined by 7a, 7c(11), 7b, and 7d(10)) in a closed position is vertical. Since the planes of Nozawa '912 in a closed position are vertical in a closed position as shown in Figs. 8 and 9, the only imaginary lines which can be inclined relative to the planes in Figs. 6, 8 and 9 of Nozawa '912 are imaginary slant lines. However, in view of the definition of the term "central closure axis" in the specification as well as the ordinary or dictionary meaning, any imaginary slant line in Figs. 6, 8 and 9 of Nozawa '912 cannot be regarded as a "central closure axis".

It should be noted that an inclination of *a plane relative to a line* (i.e., closure axis) is different from an inclination of *each line (on the plane) relative to the line* and an inclination of *a plane relative to another plane*. That is, here, the fact that some lines (i.e., 7c(11), 7d(10)) in the closed position may be inclined relative to the line of the closure axis does not mean that the plane defined by the hinge connections (i.e., 7c(11) and 7d(10)) is not inclined relative to a closure axis. Likewise, the fact that the plane defined by the hinge connections (i.e., 7c(11), 7d(10)) in the closed position may be inclined relative to another imaginary plane does not mean that the plane defined by the hinge connections (i.e., 7c(11) and 7d(10)) is not inclined relative to a closure axis.

Nonetheless, the Examiner did not traverse the applicant's reasoning, and merely repeated the conclusion that "the planes are inclined either horizontally or vertically." For the foregoing reasons, the Examiner's anticipation rejection is not proper.

**Third**, Nozawa '912 does not teach the feature of "the two connecting elements and the

two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure.” Apparently, the Examiner’s statement that:

“the limitation of the hinge connections being accessible in the mold from the inside of the closure and from outside the closure does not structurally limit the finished claimed product,”<sup>7</sup>

is based upon a misunderstanding of U.S. practice. Nothing in the second paragraph of 35 U.S.C. §112 provides a criterion for identifying one limitation as a “structural limitation” and a different limitation as a “non-structural limitation.”

Claims 1, 38 and 41 define a structure which is different and novel from those of Nozawa ‘912; by way of one example, “plug 4” exists in Nozawa ‘912 for the sole function of closing its “pouring port 2”. If this function is accurately stated by Nozawa ‘912, how could the Examiner possibly understand that “the two pairs of hinge connections are accessible in the mould from the inside of the closure ... .” when “plug 4” closes “pouring port 2”?<sup>8</sup> The mating of “plug 4” with “pouring port 2”, among other aspects of Nozawa ‘912 singularly prevent this access. Should the Examiner have evidence of record to the contrary, clarification and disclosure of that evidence are requested under 37 CFR §1.104(c)(2). Different implementations of these claims may look quite different from one another. Nothing in any clause of 35 U.S.C. §102(b) distinguishes between “structural limitations” and other types of limitations. Consequently, the failure of fully consider these claims in their respective entireties is improper, and the finality of the rejection is premature. Moreover, the action set forth in

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<sup>7</sup> Paper No. 20050110, Examiner’s Comments, page 3.

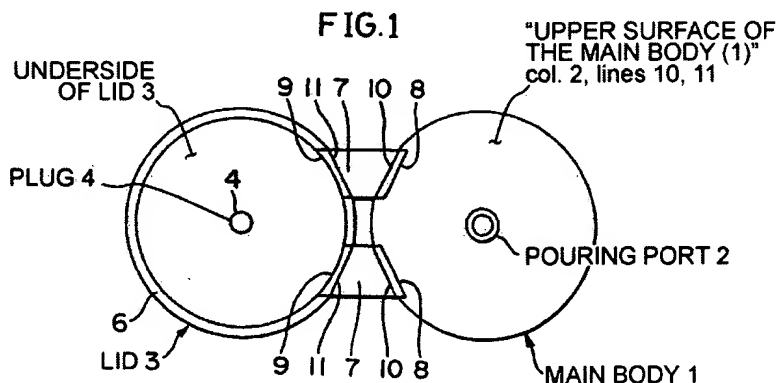
<sup>8</sup> Applicant’s claim 1, lines 12 and 13.

Paper No. 20050110 is incomplete under 37 CFR §1.104(a) and (b).

The Examiner stated that claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 are a product-by process claim, and that process limitation in a product-by-process claim is not considered for determination of patentability.

The Examiner's assertion is not proper for the following reasons. The accompanying figure taken from Nozawa '912 illustrates the first embodiment in its opened orientation in order to show the exposed upper surface of the main body (1) and the underside of lid 3, in relation to the inside surfaces of resilient belts 7.

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illustrate the significance of these features of the rejected claims. In Nozawa '912, *when the main body 1 and lid 3 are in their closed position*, plug 4 closes pouring port 2; necessarily, a cavity is formed between the "upper surface of the main body (1);"<sup>9</sup> What the Examiner has

<sup>9</sup> Nozawa '912, column 2, lines 10 and 11.

ignored is, among other things, the fact that connecting elements 23.1, 23.2 (*see*, for example either Figure 3 or Figure 4 of Applicant's original specification) are accessible in the mould from the inside of the closure and from the outside of the closure, as stated in these claims. The fact that this accessibility is unavailable with Nozawa '912 negates the possibility of anticipation under 35 U.S.C. §102(b), and this rejection must be withdrawn.

Moreover, returning again to the Examiner's statement that:

“the limitation of the hinge connections being accessible in the mold from the inside of the closure and from outside the closure does not structurally limit the finished claimed product,”<sup>10</sup>

the fact that process terms are used in a product claim does not necessarily mean that the claim is product-by-process claim. For example, such terms as “etched,” “welded,” “interbonded by interfusion,” and “condensation product” can be used to describe the physical characteristics of a product without changing the character of the claim into a product-by-process claim. Although those words appear to be process limitations, they are considered limitations on the structure of the invention, not words descriptive of a process. *In re Garnero*, 412 F.2d 276, 162 USPQ. 221 (CCPA 1969).

The Examiner has, in essence, disregarded the guidance provided by the Court in this decision, and erroneously asserted that the feature is of a molding process, not of a finished product. The issue is not whether the feature is a process limitation, but whether the feature is considered limitations on the structure of the invention although the words appear to be a process limitation. (See *In re Garnero*, 412 F.2d 276, 162 USPQ. 221 (CCPA 1969)).

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<sup>10</sup> Paper No. 20050110, Examiner's Comments, page 3.

Here, the description of the product in the mold should be regarded as a structural limitation. The shape of a mold is necessarily translated into the shape of a product. Even if the recited feature in claims 1, 38 and 41 includes the process term, the recited feature describes the physical characteristics of the product by describing the arrangement of the product.

As admitted by the Examiner and MPEP §2113, even if product-by-process claims may not be limited to the manipulation of the recited steps, product-by-process claims are limited by the structure implied by the steps. It should be noted that this case is distinguished from the case wherein the product *of the prior art* is made merely by a different process which does not imply the novel structure.

Applicant's feature of "the two connecting elements and the two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure implies the structure of the product for the above reasons. Therefore, the structure implied by the steps (*i.e.*, the feature of "the two connecting elements and the two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure") should be considered for patentability determination.

The Examiner argued that once the closure is removed from the mold, one can not determine the accessibility of the hinge connections with regard to the insider or the outside of the mold. Also, and contrary to the Examiner's assertion, the feature recited in claims can be determined from the final product. Therefore, claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 are not anticipated by the prior art.

**VIII. Claim Rejection Of Claims 3, 4 And 16 Under 35 U.S.C. §103(a)**

1. Claims 3, 4 and 16 stand rejected under 35 U.S.C. §103 as being unpatentable over Nozawa '912 in view of Dubach (US 5,392,938). Applicant respectfully traverses this rejection for the following reasons.

Supplementation of Nozawa '912 with Dubach '938 fails to remedy the deficiencies in the primary reference noted in the foregoing paragraphs.

The Examiner asserted that Nozawa '912 taught the claimed closure except for at least one element initially connecting the two closure parts in the closed position, and that Dubach '938 taught that it was known to initially secure two hinged closure parts together.

Claims 3, 4 and 16 depend effectively from claim 1. As stated above, since claim 1 is patentable, claims 3, 4 and 16 are also patentable.

Therefore, the Examiner's rejection should be withdrawn.

**IX. Rejection Of Claims 18 and 20 Under 35 U.S.C. §103(a)**

2. Claims 18 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nozawa '912 in view of Altherr (U.S. Pat. No. 5,270,011) and Gach *et al.* (U.S. Patent No. 4,826,026), respectively. Applicant respectfully traverses this rejection for the following reasons.

Supplementation of Nozawa '912 with the Examiner's proposed combination of Altherr '011 and Gach *et al.* '026 fails to remedy the deficiencies in the primary reference noted in the earlier paragraphs of these remarks.

Claims 18 and 20 depend effectively from claim 1. As stated above, since claim 1 is patentable, claims 18 and 20 are also patentable.

Therefore, this rejection is technically inaccurate, and should be withdrawn. Such action is respectfully requested.

#### **X. Allowable Claims 11, 12 And 19**

The Examiner stated that claims 11, 12 and 19 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. Claims 11 and 19 have been amended to stand in independent form; accordingly, claims 11, 12 and 19 are deemed to be allowed.

#### **XI. Premature Rejection**

Applicant notes that the rejection under the second paragraph of 35 U.S.C. §112 was not necessitated by the previous amendment to claim 1. Consequently, designation of Paper No. 20050110 as "final" is premature. Withdrawal of this designation is respectfully requested.

#### **XII. Fees Incurred**

No fees are incurred by this Second Amendment After Final. Should the other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,



Robert E. Bushnell,  
Attorney for the Applicant  
Registration No. 27,774

1522 "K" Street, N.W., Suite 300  
Washington, D.C. 20005  
(202) 408-9040

Folio: P56559PCT  
Date: 5/24/05  
I.D.: REB/kf